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| 09/832,828 | 04/12/2001 | Michal Kahan | Q60535 | 1955 |
| <div>7590 07/13/2007</div> <div>SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC 2100 PENNSYLVANIA AVENUE, N.W. WASHINGTON, DC 20037-3213</div> | | | | |
| | | | EXAMINER HANNE, SARA M | |
| | | | ART UNIT 2179 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/832,828

Applicant(s)

KAHAN ET AL.

Examiner

Sara M. Hanne

Art Unit

2179

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/30/07.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7, 8, 10-23, 26-41 and 43-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7, 8, 10-23, 26-41 and 43-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/30/07 has been entered.
2. Claims 1-4, 7, 8, 10-23, 26-41, 43-54 are pending in the application.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 14-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 14-18 recite an executable program comprising pieces of executable code. Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and cannot be realized as a statutory entity, and therefore is nonstatutory functional descriptive material.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-4, 7, 8, 11-17, 19-23, 26-29, 31-41, 43-45, and 47-53, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim, US Patent 6546002 and further in view of McNamar et al., US Patent 7089202 hereinafter McNamar.

As in Claims 1, 14, 19, 34 and 47, Kim teaches transmitting from the server, a provisioning profile associated with the subscriber to an outside application executing on a data item computer (Fig. 3, 4 with corresponding text), receiving at the server, data items from a outside application executing on a data item computer (Col 9, lines 23 et seq.) including personalized information transmitted to the subscriber where a portion of the received data items comprised personalized information transmitted to the

Art Unit: 2179

subscriber according to the provisioning profile associated with the subscriber (Fig. 3, 4 with corresponding text) arranging at the server, the received data items for display according to a plurality of subscriber-selected presentation rules (Col. 11, line 1 et seq.), wherein each data item is associated with a generic action menu or an application specific menu corresponding to the outside application executing on the data item computer (Col. 10, line 40 et seq.) and transmitting from the server, the arranged data items to the terminal of the subscriber (Col. 16, lines 12 et seq.).

While Kim teaches such a system, they fail to explicitly teach the personalized information to be pushed to the subscriber from the server as recited in the claims. McNamar teaches a networked system for data transmission of a personalized page similar that of Kim. In addition, McNamar further teaches the personalized information to be pushed to the subscriber from the server (Col. 25, lines 44 et seq.). It would have been obvious to one of ordinary skill in the art, having the teachings of Kim and McNamar before him at the time the invention was made, to modify the mobile system taught by Kim to include the personalized information to be pushed to the subscriber from the server of McNamar, in order to obtain a server initiated push of a personalized information, arranged at the server according to subscriber-selected presentation rules, to the subscriber terminal. One would have been motivated to make such a combination because a way to provide pre-selected information to the user when it becomes available without the user having to continuously access the site until it is available would have been obtained, as taught by McNamar (Col. 26, lines 1-7).

Art Unit: 2179

As in Claims 2, 15 and 20, Kim teaches updating the provisioning profile based on a command received from the terminal (Fig. 7 and corresponding text)

As in Claims 3, 16, 22, 29 and 38, Kim further teaches updating the provisioning profile by transmitting this command to the control server to update a presentation rule with one of the data items with the wireless gateway and using a controller (Fig. 7 and corresponding text).

As in Claims 4, 23 and 39, Kim teaches the control server storing the updated provisioning profile in a subscriber database and further in reference to Claim 39, on the database server (Fig. 7, ref. 542-546 and corresponding text).

As in Claims 7, 26 and 43, Kim teaches the control server storing the received data items in a terminal subscriber's database (Fig. 3,4 and corresponding text) by the control server as in further reference to Claim 43.

As in Claims 8, 17, 27-28, 44-45 and 52-53, Kim teaches an application adapter translating the received data item to comply with the application interface contract if it does not already (Col. 8, line 36, et seq.).

As in Claim 11, Kim teaches the formatted data item to be transmitted to the to the receiving terminal, and furthermore by using a data communications protocol (Col. 8, line 36, et seq.).

As in Claim 12 and 32, Kim also teaches the terminal being a mobile terminal (ref. 1525).

As in Claim 13 and 33, Kim also teaches the terminal being a client terminal (ref. 1525).

Art Unit: 2179

As in Claims 21 and 37, Kim teaches the wireless gateway to receive a command from the terminal (cellular requires wireless connection).

As in Claim 31, Kim teaches the wireless gateway to transmit data items to the terminal (cellular requires wireless connection).

As in Claims 35 and 48, Kim teaches an operator platform for accessing the subscriber's profile (Fig. 3, 4 and corresponding text).

As in Claims 36 and 49, Kim teaches a wireless gateway connected to the web server (it is common to one of ordinary skill in the art for a web server to be connected to a wireless gateway as suggested in Col. 6, line 22 et seq.).

As in Claims 40 and 50, Kim fails to explicitly teach a short message service center connected to the control server as recited in the claims. Within the field of the invention, it would be obvious to one of ordinary skill in the art to provide a SMS center with a cellular network. One would have been motivated to make such a combination because a communication system to cellular subscriber would have been obtained.

As in Claims 41 and 51, Kim teaches an IVR (Interactive voice response) server (Col. 6, line 46 et seq.).

8. Claims 10, 18, 30, 46 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Kim, US Patent, McNamar et al., US Patent 7089202 hereinafter McNamar and in further view of Gerace, US Patent 5848396.

As in Claims 10, 18 and 30, Kim and McNamar teach a mobile networking system that edits and sends data from the provider application according to ' user-

Art Unit: 2179

updateable profiles, associating each data item with a generic action menu or an application specific menu and pushing the personalized information to the subscriber from the server as seen supra. While Kim and McNamar teaches such a system, they fail to explicitly teach the generating of a terminal subscriber home page according to a presentation rule associated with the data items as recited in the claims. Gerace teaches a networked system for data transmission according to user profiles similar to that of Kim and McNamar. In addition, Gerace further teaches a control server (ref 79) which generates a subscriber home page according to a user's presentation rule in the profile (Figure 4a, and corresponding text). It would have been obvious to one of ordinary skill in the art, having the teachings of Kim, McNamar and Gerace before him at the time the invention was made, to modify the networked system with push technology for providing personalized information to a subscriber terminal taught by Kim and McNamar to include the home page generation according to user defined performance rules of Gerace, in order to obtain a user-defined automatic dynamic homepage for a mobile system. One would have been motivated to make such a combination because a more personalized system for obtaining web information would have been obtained, as taught by Gerace.

As in Claims 46 and 54, Kim and McNamar teach a mobile networking system that edits and sends data from the provider application according to user-updateable profiles and associating each data item with a generic action menu or an application specific menu as seen supra. While Kim and McNamar teach such a system for obtaining data items and generating a home page according to the user's profile and

Art Unit: 2179

rules, they fail to show the sending of a terminal subscriber home page to the web server as recited in the claims. Gerace teaches a networked system for data transmission according to user profiles similar to that of Kim and McNamar. In addition, Gerace further teaches transmitting the Home Page to the web server (Fig. 1 and corresponding text). It would be obvious to one of ordinary skill in the art, having the teachings of Kim, McNamar and Gerace before him at the time the invention was made, to modify the networked system with push technology for providing personalized information to a subscriber terminal taught by Kim and McNamar to include the transmitting of the Home Page to the web server of Gerace in order to obtain a pushed web transmission of a customized menu. One would have been motivated to make such a combination in order to keep a global ' copy of the generated page if the user wished to access it from other devices on the same provider or to share the user's formatted page with other users.

Response to Arguments

Applicant's arguments with respect to claims 1-4, 7, 8, 10-23, 26-41 and 43-54 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 2179

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara M. Hanne whose telephone number is (571) 272-4135. The examiner can normally be reached on M-F 7:30am-4:00pm, off on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WEILUN LO can be reached on (571) 272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

smh



WEILUN LO
SUPERVISORY PATENT EXAMINER